REMARKS

This Response is submitted in reply to the Office Action dated September 15, 2008, and in accordance with the telephone interview conducted on January 8, 2009. Claims 1, 5, 8, 9, 11, 16, and 18 have been amended. Claims 21 to 96 stand withdrawn. No new matter has been added by these amendments.

A Request for Continued Examination is submitted herewith. A Petition for a One Month Extension of Time is submitted herewith. Please charge deposit account number 02-1818 for the cost of this Request for Continued Examination, this Petition for a One Month Extension of Time, and for any fees associated with this Response.

Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that if the Examiner does not allow this application, the Examiner provide an upcoming Office Action which will ". . . identify any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

The Office Action rejected Claims 1 to 4, 12 to 14, 19, and 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,716,529 to Nakayama, U.S. Patent No. 7,018,293 to Brown et al. ("Brown"), and in further view of an article titled Endgame Tablebase ("the Endgame article").

Nakayama discloses an electronic game apparatus that stores handicap data for certain types of games such as gobang, Othello, and chess. In one version of Nakayama where the electronic game apparatus of Nakayama is configured for gobang, the game includes game chips or pieces, wherein each chip is black on one side and white on the other side. A player is assigned one chip color and a computer is assigned the other chip color. The chips for the gobang game are placed on a go board. A player and a computer alternate placing their assigned chips on the board for each of a plurality of moves in a game. In the gobang game, when black chips flank a white chip, the white chip is turned over and becomes a black chip. Alternatively, when white chips flank a black chip, the black chip is turned over and becomes a white chip. The player and computer compete to become the first to form eight of their assigned chips in an adjacent line on the board. The electronic game apparatus also enables the player to

play the gobang game at different difficulty levels by selecting a handicap. Each difficulty level included in the gobang game is associated with a database that stores the number of possible moves the computer is configured examine for an optimal game move. For example, as illustrated in Fig. 6, if the player selects the first level, the computer opponent is only configured to determine/analyze one move to make. If the player selects the third level for a more challenging gobang game, the computer is configured to determine the optimal move out of three possible moves. The more moves the computer is able to determine, the greater the likelihood the computer will select the best possible move in response to a player's move. That is, the computer becomes a better opponent when provided with greater opportunities to examine gobang game moves.

Brown discloses a bonus game including a representation of an Othello type game with a six-by-six grid of squares. The game includes game chips or pieces used in the bonus game, wherein each chip is black on one side and white on the other side. In an example shown in Fig. 8, the player selects a color game piece (for example, the black side). The bonus game begins with four pieces 128, 130, 132, and 134 in the center of the six-by-six board with the player's selected color displayed. Surrounding these four pieces are twelve pieces with the opponent's color which is the color not selected by the player (in this example, the white side). The operation of the bonus game is based on the basic legal move in the Othello type board game, which is placing pieces with the player's color next to any opponent's colored pieces, such that an "outflanking" of the opponent's colored pieces may occur. Outflanking occurs when a game piece with the player's color is placed in an empty square such that one or more of the opponent's pieces are in consecutive squares (in a line) between the new position of the player's piece and another piece of the player's color. This may occur on a horizontal, vertical or diagonal line. After the piece is played, all of the outflanked pieces of the opponent's color are flipped or turned over so that they now show the player's color. According to this game's methodology, a piece cannot be legally placed in an open square that does not outflank one of the opponent's piece.

Brown also discloses that the gaming device uses a random number generator to randomly select one of the twenty open squares on the board. The gaming device can

select a legal or illegal open square. Once a square is selected, a new piece with the player's color is placed in the square and any opponent (white in this example) pieces outflanked by the new player piece and another player piece are turned to the player's color (black in this example). After the opponent pieces are flipped, the gaming device determines the number of the player's pieces (black in this example) on the board and highlights the corresponding value in a paytable. The value is displayed to the player in a bonus win meter. The random selection of squares continues until an illegal open square is selected or the 12 pieces are placed on the game board for the player.

The Endgame article discloses an endgame tablebase that includes all possible chess moves when a limited number of chess pieces remain on a chess board (i.e., certain chess endgames). The Endgame article discloses that in principle, it is possible to solve any game under the condition that the complete state is known and there is no random chance. Solutions are known for simple games such as tic-tac-toe, connect four, and a certain version of checkers. The Endgame article discloses that only chess endgames with up to six pieces have been solved (i.e., endgames for pieces greater than six pieces have not been solved). The Endgame article also discloses that games such as chess from the beginning and Go have not been solved because the games are too complex.

Amended independent claim 1 is directed to a method of operating a gaming device that includes (a) randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, (b) causing at least one display device to display a playing board having a plurality of positions, (c) enabling a player to individually place one of a plurality of player chips at one of the positions, wherein placement of the player chip that causes at least one of a plurality of game chips to be flanked on opposite sides by player chips converts each flanked game chip to a player chip, (d) using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions, wherein placement of one of the game chips that causes at least one player chip to be flanked on opposite sides by game chips converts each flanked player chip to a game chip, (e) repeating steps (c) and (d) until the player has placed a provided amount of player chips onto the

positions of the playing board, and (f) thereafter providing an award to the player based on the remaining number of player chips after the player placed the provided amount of player chips onto the positions.

Applicant submits, as discussed during the interview and as previously stated in the Response to Office Action dated June 20, 2008, that the Office Action is improperly ignoring that Nakayama and Brown are not properly combinable with the Endgame article because the Endgame article expressly disclaims that endgame tablebases can be applied to complex games such as Othello. Specifically, the Endgame article discloses that only chess games with a maximum of six remaining chess pieces have been solved. The Endgame article also discloses that games such as chess (from the starting position) and Go have not been solved because the complexity of these games is too vast for computers to evaluate for all possible positions. That is, endgame tablebases do not exist for games such as chess (from the starting position) and Go because these games remain unsolved. The Endgame article also does not disclose if any endgame tablebases exist for Othello. Similar to the game of chess (from the starting position) and Go, the game of Othello is a complex game that includes a large number of game pieces and requires a player to evaluate numerous potential game moves with each player turn of placing a game chip at a position on the playing board. The games disclosed in both Nakayama and Brown relate to complex games based on Othello. Based on the disclosed limitations of the endgame tablebases operating with complex games such as Othello, the Endgame article is not properly combinable with the game of Nakayama or the game of Brown because these games are based on Othello.

Moreover, regardless of the express disclaimer described above, Applicant submits that the Endgame article is not properly combinable with and teaches away from Nakayama and Brown because the Endgame article is applicable for games of decreasing complexity as the game progresses, while Nakayama and Brown are directed to games of increasing complexity as the game progresses. For example, in a game of chess, at the beginning of the game, the chess board includes the maximum number of game pieces, wherein as the game progresses, game pieces are eliminated from the game board. The reduction in game pieces thus reduces the complexity of the

chess game. In this example, once the number of chess game pieces is reduced to six or fewer pieces, the complexity of the chess game has been reduced to the point that the endgame tablebases can be applied to solve the game. In contrast, in games such as Othello, the game begins with a limited number of game pieces, wherein as the game progresses, more game pieces are added to the game board. With the addition of each additional game piece that is added as the game of Othello progresses, the players must contend with additional game moves to consider. The additional game pieces and possible moves to consider with each player turn increases the level of complexity of the game, rather than reduces the complexity of the game. Applicant therefore submits that because Nakayama and Brown are not properly combinable with the Endgame article, the rejections are improper and should be withdrawn.

The Office Action stated that Nakayama does not disclose using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a designated target number of player chips remaining after a player places each of a provided amount of player chips onto the positions, wherein the designated target number of player chips is randomly determined and greater than zero. The Office Action further stated that the Endgame article does not specifically disclose that the designated target at the conclusion of the game is randomly determined. However, the Office Action stated that:

> it would have been obvious to one skilled in the art at the time of the invention that after the player randomly places each player chip, the situation presented to the computer is randomly changed. Thusly, the computer must then randomly determine a designated number of player chips to be remaining, in light of the current situation, in order to optimally place it's next game chip to minimize the number player pieces remaining after the game chip is placed (P. 1), and thusly randomly changes the designated number of player pieces the computer would need to be at the Endgame in order to achieve its goal of defeating the player opponent (P. 1). (emphasis added).

In other words, the Office Action appears to state that if a player randomly places a player chip on a game board, a computer's opposing move to place a chip on the game board will also necessarily be random. The Office Action appears to conclude that because both the player's moves and the computer's moves are random, it follows that the designated target number of player chips is also randomly generated.

As discussed during the interview, Applicant submits that assuming, arguendo, that Nakayama, Brown, and the Endgame article are properly combinable, the method of operating a gaming device resulting from such a combination does not disclose that a designated target number of player chips is randomly determined because the player and the computer do not randomly place any chips on a game board. The combination of Nakayama, Brown, and the Endgame article results in a method of operating a gaming device which includes placing game pieces on a game board to win the game. In such a combination, the player wins the game based on the player having a predetermined maximum number of player chips (e.g., all of the chips on the game board are the player's chips) on the game board at the end of the game. The player must determine (e.g., based on a strategy) where to place player chips on the game board to achieve the predetermined maximum number of player chips on the game board and win the game. If the player randomly places player chips on the game board, the player will not obtain a predetermined maximum number of player chips at the end of the game and thus win the game. That is, the player does not randomly place player chips because an element of skill is required on the player's part to achieve the maximum number of player chips on the game board and win the game.

The player's opponent (e.g., the computer) in the combination of Nakayama, Brown, and the Endgame article also does not randomly place chips on the game board. In such a combination, the computer attempts to obtain a predetermined maximum number of opponent chips on the game board at the end of the game and win the game. That is, the computer does not randomly place opponent chips because the computer determines where to place opponent chips on the game board based on an analysis of the chips that have already been placed on the game board so that the computer attempts to achieve the predetermined maximum number of opponent chips on the game board and win the game. Accordingly, based on the Office Action's logic, it follows that the gaming device resulting from the combination of Nakayama, Brown, and the Endgame article does not disclose that a designated target number of player chips is randomly determined because the player and the computer do not randomly place chips on the game board.

Applicant also submits that the Office Action's apparent conclusion that if the player places a chip on the game board randomly, any subsequent placement of chips (e.g., by the player or the computer) is also random is based on flawed logic. That is, a first random event in a game does not make a subsequent action also random. Stated another way, even if a player's first chip is randomly placed on a game board, an opponent does not randomly place a chip on the game board simply because the player's first chip was randomly placed.

Applicant further submits that even if Nakayama, Brown, and the Endgame article are properly combinable, the resulting method of operating a gaming device would function differently than a method of operating a gaming device that includes randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions.

Page 3 the Office Action stated that:

> Nakayama does not specifically disclose using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a designated target number of player chips remaining after a player places each of a provided amount of player chips onto the positions, wherein the designated target number of player chips is randomly determined and greater than zero.

The Office Action then relied on the Endgame article to disclose, among other things, a method for determining a game piece move based on a desired number of player pieces remaining at the end of a game.

Applicant respectfully disagrees with the Office Action's characterization of the Endgame article and submits that the functionality of games disclosed in the Endgame article (e.g., tic-tac-toe, connect four, checkers, and endgames of chess) do not disclose randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions.

In the games of tic-tac-toe and connect four, the objects of the games are for one opponent to be the first to form an adjacent string of three or four identical player markers respectively without regard to a designated target number of player markers remaining. In the games of tic-tac-toe and connect four, each player is assigned a plurality of identical player markers. The players alternate placing their player markers on a game board until one of the players obtains the winning string of identical player markers. A player's focus in both of the games is to form the winning string of identical player markers. That is, in the games of tic-tac-toe and connect four, achieving a designated target number of player markers remaining on the game board is not a factor for either opponent in achieving the winning string of identical player markers. Thus, unlike the method of operating a gaming device of amended independent claim 1, the combination of Nakayama, Brown, and the Endgame article, when applied to a tic-tac-toe or a connect four game, does not disclose randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions.

In the game of chess, the object of the game is for each player to capture the opponent's king without regard to the designated target number of player pieces remaining on the game board. In the game of chess, each player starts with a set of a plurality of different player pieces, wherein each set of player pieces includes a king. The players maneuver their player pieces around a game board and attempt to capture their opponent's king. A player's focus in the game is to capture the opponent's king before the player's king is captured. Thus, unlike the method of operating a gaming device of amended independent claim 1, the combination of Nakayama, Brown, and the Endgame article, when applied to a chess game, does not disclose randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions.

In the game of checkers, the object of the game is for one player to capture all of an opponent's markers (i.e., the number of remaining opponent markers is equal to zero). In the game of checkers, the players start with an equal number of assigned player markers on a game board. The players maneuver their assigned markers around the game board and attempt to capture all of their opponent's markers. When a player captures an opponent's marker, the opponent's marker is removed from the game board. When one player has removed all of their opponent's markers from the game board, the player wins the game. That is, in the game of checkers, because the players are focused on reducing the number of their opponent's markers to zero, the game of checkers is functionally different from achieving a designated target number of player chips remaining after a player places each of a provided amount of player chips onto the positions, wherein the designated target number of player chips is randomly determined and greater than zero. Thus, unlike the method of operating a gaming device of amended independent claim 1, the combination of Nakayama, Brown, and the Endgame article, when applied to a checkers game, does not disclose randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions.

Applicant further submits as previously discussed in the Response to Office Action of June 20, 2008, Brown also does not disclose randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions.

Moreover, it would not have been obvious to one of ordinary skill in the art to modify Nakayama, Brown, and the Endgame article to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, the method of operating a gaming device of amended independent claim 1 includes, amongst other elements, randomly generating a designated target number of player chips, wherein the designated target number of

player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions.

Accordingly, for at least these reasons, Applicant respectfully submits that amended independent claim 1 is patentably distinguished over Nakayama and Brown in view of the Endgame article and is condition for allowance.

Claims 2 to 4, 12 to 14, 19, and 20 depend directly or indirectly from amended independent claim 1 and are also allowable for the reasons given with respect to amended independent claim 1 and because of the additional features recited in these claims.

The Office Action rejected claims 5 to 11 under 35 U.S.C. 103(a) as being unpatentable over Nakayama, Brown et al. ("Brown"), the Endgame article, and further in view of U.S. Patent No. 6,439,995 to Hughs-Baird et al. ("Hughs-Baird").

Hughs-Baird discloses an apparatus and method that includes a gaming device having a bonus round with multiple selection groups. The bonus round does not end upon an end-bonus indicator; rather, the bonus round ends when the player chooses a predetermined number of selections from the last or final selection group. The last or final selection group includes an award indicator associated with each selection. In one embodiment of Hughs-Baird, the number of player choices or picks in the final selection group is determined from a selection group preceding the final selection group. However, the number of picks could be determined in any suitable manner.

Page 8 of the Office Action stated that:

> It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Nakayama, Brown and Hughs-Baird in order to provide a bonus game wherein awarding the player is based on a combination of values associated with positions having player chips as the inventions are analogous gaming devices in the same field of endeavor.

Applicant submits that regardless of whether it would have been obvious to include a bonus game wherein awarding the player is based on a combination of values associated with positions having player chips, neither Nakayama, Brown, and further in view of the Endgame article nor Hughs-Baird individually or in combination, disclose

randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Nakayama, Brown, and further in view of the Endgame article and Hughs-Baird to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, claims 5 to 11 each includes randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions. Accordingly, for this reason and the reasons provided with respect to amended independent claim 1, Applicant respectfully submits that claims 5 to 11 are patentably distinguished over Nakayama, Brown, the Endgame article and further in view of Hughs-Baird and are in condition for allowance.

The Office Action rejected claims 15 to 18 under 35 U.S.C. 103(a) as being unpatentable over Nakayama, Brown et al. ("Brown"), the Endgame article, and further in view of U.S. Published Patent Application No. 2002/0090988 to Frost et al. ("Frost").

Frost discloses a gaming table in which the outcome of the game is determined manually, and in which players place bets electronically and wins or losses are calculated electronically. The gaming system is applicable to any suitable game including roulette.

Page 9 of the Office Action stated that:

> It would have been obvious to combine the teachings of Nakayama, Brown, and Frost in order to provide a game wherein awarding the layer is based on a combination of values associated with chips as the inventions are analogous gaming devices in the same field of endeavor.

Applicant submits that regardless of whether it would have been obvious to include a game wherein awarding the player is based on a combination of values associated with chips, neither Nakayama, Brown, and further in view of the Endgame article nor Frost individually or in combination, disclose randomly generating a designated target number

of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Nakayama, Brown, and further in view of the Endgame article and Frost to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, claims 15 to 18 each includes randomly generating a designated target number of player chips, wherein the designated target number of player chips is greater than zero, and using a table in memory that is weighted according to the designated target number of player chips remaining to individually place one of the plurality of game chips at one of the positions. Accordingly, for this reason and the reasons provided with respect to amended independent claim 1, Applicant submits that claims 15 to 18 are patentably distinguished over Nakayama, Brown, in view of the Endgame article, and further in view of Frost and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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